IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Karen L. FINCHER *et al.*
Appl. No.: 09/849,529
Filed: May 7, 2001
Title: **Nucleic Acid Molecules and Other Molecules Associated with Plants**

Art Unit: 1631
Examiner: Michael L. BORIN
Atty. Docket: 16517.247/38-21(51893)B

Response to Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed September 17, 2002 (paper number 7), Applicants submit the following amendments and remarks.

REMARKS

The application presently contains claims 1-9. In the Office Action mailed August 17, 2002, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 1 and 2 drawn to polynucleotides, classified in class 536, subclass 23.1.

Group II: Claim 3, drawn to a purified polypeptide encoded by a polypeptide of Group I, classified in class 530, subclass 300.

Group III: Claims 3-9, drawn to a transformed plant, classified in class 800, subclass 205.

Upon the election of any one of the preceding groups, the Examiner further required restriction to a single sequence.

Although Applicants respectfully request clarification of this issue, it would appear from the Examiner's comments that claim 3 should be included in Group III only, as the claim is directed to a transformed plant. Furthermore, as Group II is drawn to a purified polypeptide encoded by a polynucleotide of Group I, it appears that claim 2 would be encompassed by this classification, leaving only claim 1 in Group I. In the event that Applicants' understanding of the claim groupings is correct, Applicants respectfully traverse the restriction requirement, and provisionally elect the subject matter of Group I, presented in claim 1, and SEQ ID NO: 1, for further prosecution.

Regardless, Applicants submit that the complete examination of the application would be handled most expeditiously by treating all of the pending claims as a single entity. As MPEP § 803 directs, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

No serious burden is created for the Examiner by running a simultaneous computerized search of the nucleic acids of Group I, the polypeptide encoded by those nucleic acids (Group II), and a plant transformed by those nucleic acids (Group III). The single search may be run in conjunction with databases such as those available at www-ncbi.nlm.nih. A single search for a particular nucleotide sequence and its translation product, for example, would automatically yield results from Groups I and II without any undue burden on the Examiner. Furthermore, the same search would yield the results from the transformed plants of Group III.

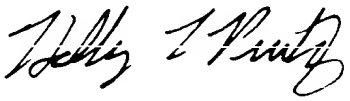
further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided ... to permit a reasonable number of such nucleotide sequences to be claimed in a single application." (MPEP, 8th ed., August 2001, Section 803.04). The MPEP further provides that "[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes." (emphasis added) *Id.* While the Examiner requires that a single nucleotide sequence be selected, no reason has been provided for this deviation from articulated Patent Office policy. (MPEP, 8th ed., August 2001, Section 803.04).

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore must be withdrawn. However in order to facilitate prosecution, Applicants have provisionally elected, with traverse, the subject matter of Group I (claim 1) and the specific nucleotide sequence set forth in SEQ. ID NO: 1.

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding restriction requirement and to pass this application to issue. Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (202) 942-5243.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees are due in conjunction with this filing. However, if any fees under 37 C.F.R. §§ 1.16 or 1.17 are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter Deposit Account No. 50-2387, referencing matter number 16517.247.

Respectfully submitted,



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Date: October 15, 2002

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